

REMARKS

I. Restriction as to Inventions

The Examiner has issued a restriction requirement stating that the application claims four separate inventions. Specifically, the Examiner identifies the four inventions as being:

Group I: Claims 1-31, drawn to a method for identifying multiple different transcription factors in a cell sample, classified in class 435, subclass 91.1.

Group II: Claims 32-39, drawn to a method for characterizing a cell type of a cell sample, classified in class 435, subclass 70.1.

Group III: Claims 39-42, drawn to a method for diagnosing a disease state in a cell sample, classified in class 424.

Group IV: Claims 43-46, drawn to a method for screening transcription factor modulators, classified in class 435, subclass 91.5.

Pursuant to 37 C.F.R. 1.142, Applicants elect Group I (Claims 1-31) without traverse and cancels without prejudice the claims of Groups II, III and IV (Claims 32-46).

II. Restriction as to Subgenus

The Examiner has also required that upon selection of any of Groups I-IV, Applicants must further elect a specific subgeneric composition from numerous groups of genus. Applicants hereby elect without traverse the following subgenus:

1) within the genus of activated transcription factors, a subgenus of activated transcription factors listed in the table shown in Figure 2 under the column labeled as "Transcription Factor";

2) within the genus of cis elements, a subgenus of cis elements listed in the table shown in Figure 2 under the column labeled as "Cis-Element";

3) within the genus of a promoter sequence 3' to a cis element, a subgenus of the promoter disclosed in the Specification on page 17, lines 15-21; and

4) within the genus of reporter sequence 3' to a cis element, a subgenus of reporter sequence listed in the table shown in Figure 2 under the column labeled as "Reporter Sequence".

III. Election of Species

The Examiner has also required Applicants to elect a single disclosed species for prosecution on the merits. Applicants hereby elect without traverse the following species:

- 1) at least 10 different cis elements (claim 2);
- 2) at least 2 copies of the cis element (claim 6);
- 3) cis element having a length of 5-100 base pairs (claim 9);
- 4) the variable sequence of the reporter sequence being at least 15 bases in length (claim 12);
- 5) Hela cell line as a species of the mammalian cell line (claim 18);
- 6) at least 10 different reporter sequences (claim 21);
- 7) 5' priming sequence, the whole or a part of which is included in or a complement of the reporter sequences listed Figure 2 under the column labeled as "Reporter Sequence" (claim 25);
- 8) 3' priming sequence, the whole or a part of which is included in or a complement of the reporter sequences listed Figure 2 under the column labeled as "Reporter Sequence" (claim 25);
- 9) a library of hybridization probes that hybridize to the reporter sequences listed Figure 2 under the column labeled as "Reporter Sequence" or to the complements thereof (claim 27);
- 10) a reporter protein that can be expressed by the cell as disclosed in the Specification on page 18, lines 22-26 (claim 29);
- 11) a library of antibodies that are selective for the expressed protein as disclosed in the Specification on page 14, lines 23-24 (claim 30); and
- 12) a diseased cell that is a human diseased cell such as a HeLa cell (new claim 50).

Accordingly, claims 3-8, 10-11 and 13-17 are withdrawn as being directed to the non-elected species pursuant to 37 C.F.R. §1.142(b). However, Applicants reserve the right pursuant to 37 C.F.R. §1.141 to pursue claims to the non-elected species or subgenus in this application in the event that a generic claim is found to be allowable.


Applicants also reserve the right pursuant to 35 U.S.C. §121 to file one or more divisional applications directed to the non-elected species or subgenus during the pendency of the present application.

CONCLUSION

The Commissioner is authorized to charge any additional fees which may be required, including petition fees, or credit any overpayment to Deposit Account No. 23-2415 (Attorney Docket No. 26757-709).

WILSON SONSINI GOODRICH & ROSATI
Respectfully submitted,

Date: Nov 20. 2003

By: 
Shirley Chen, Ph.D.
Registration No. 44,608

650 Page Mill Road
Palo Alto, CA 94304-1505
(650) 565-3856
Client No. 021971